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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92050789
Party	Plaintiff Nartron Corporation
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Submission	Opposition/Response to Motion
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Date	10/20/2009
Attachments	Combined BIO to HP Mot to Suspend and BIS of Mot to Compel.pdf (25 pages) (753610 bytes)

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

NARTRON CORPORATION

Petitioner,

v.

Cancellation No. 92050789

**HEWLETT-PACKARD
DEVELOPMENT COMPANY, L.P.,**

Respondent.

**PETITIONER'S COMBINED BRIEF
IN OPPOSITION TO RESPONDENT'S MOTION TO SUSPEND
AND IN SUPPORT OF PETITIONER'S MOTION TO COMPEL**

I. INTRODUCTION

Petitioner, Nartron Corporation (“Nartron” or “Petitioner”) hereby responds to Hewlett-Packard Development Company, L.P.’s (“HP” or “Respondent”) Motion to Suspend Proceedings. Nartron does not consent to HP’s motion and respectfully requests that the Board deny HP’s motion with respect to outstanding discovery responses. Nartron further requests that the Board compel HP’s response to discovery requests served August 27, 2009.

HP has moved for summary judgment on the ground that HP’s TOUCHSMART is not likely to cause confusion with Nartron’s SMART TOUCH trademark. HP filed its Motion for Summary Judgment concurrently with the subject Motion to Suspend on September 30, 2009, just one (1) day before HP’s deadline for responding to Nartron’s August 27, 2009 discovery requests. In lieu of responding to HP’s discovery requests, HP moved for the summary judgment on the eve of its deadline for responding to discovery requests, as HP’s responses would undoubtedly raise genuine issues of material fact on (1) the *du Pont* factors raised on HP’s motion, and (2) the more significant *du Pont* factors disregarded by HP. HP’s maneuver demonstrates that there are genuine issues of material fact precluding summary judgment.

Pursuant to Trademark Rule 2.120(e), Nartron’s counsel, Hope Shovein, made the required good faith effort to resolve the matters raised in the present motion to compel. HP’s counsel, Jeffrey Faucette, sent an e-mail to Ms. Shovein on September 30, 2009, indicating that HP did not intent to respond to discovery. Ms. Shovein promptly notified HP’s counsel that proceedings are not automatically suspended upon filing of a motion for summary judgment, and HP remained obligated to respond to discovery requests. HP disagreed.

As the following will show, Nartron's Motion to Compel is germane to the Motion for Summary Judgment pending before the Board.

II. DISCUSSION

A. Proceedings Are Not Automatically Suspended

The filing of a motion for summary judgment does not automatically suspend proceedings. "When a party files a timely motion for summary judgment, the Board will suspend proceedings in the case with respect to all matters not germane to the motion.... The filing of a summary judgment motion does not, in and of itself, automatically suspend proceedings in a case; rather, proceedings are suspended when the Board issues an order to that effect." TBMP 528.03; CFR § 2.127(d).

The Board has not issued an order suspending proceedings.

Furthermore, the parties remain obligated to respond to outstanding discovery requests while such motion is pending. "[O]n a case-by-case basis, the Board *may find* that the filing of a motion for summary judgment provides a party with good cause for not complying with an otherwise outstanding obligation, for example, responding to discovery requests." TBMP 528.03 (*emphasis added*).

This Board has required parties to abide by their discovery obligations while a motion for summary judgment is pending:

[T]he mere filing of a motion for summary judgment (or any other motion which is potentially dispositive of a case) does not automatically suspend a proceeding. Instead, only an order by the Board formally suspending proceedings has such effect. Thus, since the Board did not issue an order suspending this case pending disposition of applicant's motion for summary judgment until April 17, 1985, applicant was obligated to respond to opposer's discovery

requests by March 11, 1986 and consequently should also have filed a motion, *supported by a showing of good cause*, to extend such time with its first motion for summary judgment. ...[T]he pendency of applicant's first motion for summary judgment does not constitute good cause for not timely responding to opposer's outstanding discovery requests. ...[I]t is clear that rather than acting in accordance with a sincere belief that the filing of the first motion for summary judgment should operate to stay responses to opposer's discovery requests, applicant's counsel was not acting in good faith to resolve the dispute since discovery in proceedings before the Board is not governed by any concept of priority.

Giant Food, Inc. v. Standard Terry Mills, Inc. 229 USPQ 955, 966 (TTAB1986)(*emphasis added*).

Significantly, HP's Motion to Suspend is not supported by the requisite showing of good cause. Indeed, the timing of HP's Motion to Suspend indicates that HP was *not* acting in good faith to resolve the dispute.

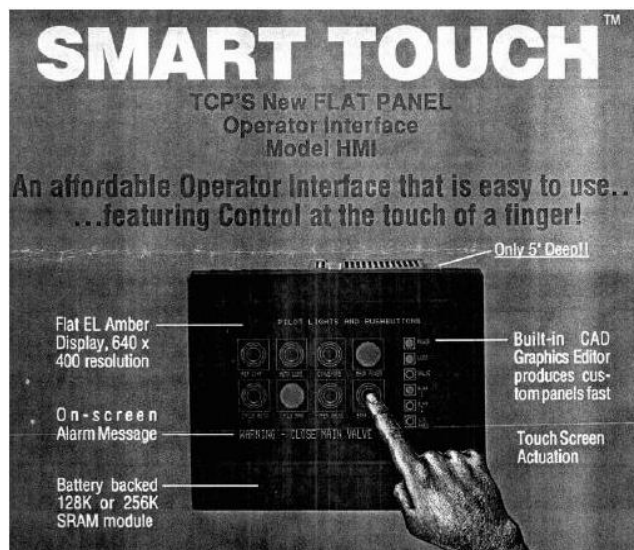
B. The Board Should Compel Responses

If "a party fails to answer an interrogatory submitted under Rule 33" or "fails to respond that inspection will be permitted – or fails to permit inspection – as requested under Rule 34," the discovering party "may move for an order compelling an answer, designation, production, or inspection." Fed. R. Civ. P. 37(3)(2)(B). For the convenience of the Board, Nartron's First Interrogatories and Rule 34 Requests, served August 27, 2009, are attached hereto as **Exhibit 1**.

In determining whether there is any genuine issue of material fact regarding likelihood of confusion, the Board must consider the factors set forth in *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). Nartron sought to conduct discovery on all *duPont* factors, including HP's intent in selecting TOUCHSMART. In particular, Nartron served Rule 34 requests seeking production of search reports to learn if HP knew of Nartron's rights prior

to adopting TOUCHSMART. If Nartron's registration or use of SMART TOUCH appeared on a search report commissioned by HP (which is discoverable), it would be probative of HP's intent in selecting and adopting TOUCHSMART. "As a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment." *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); *see also Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993).

Furthermore, HP fails to address key evidence of record in this proceeding. Specifically, HP's motion ignores Paragraph 9 and Exhibit 2 to the Petition to Cancel, which indicate that HP's use of TOUCHSMART in connection with a computer monitor and display screens is identical to Petitioner's use of SMART TOUCH for electronic sensors. Exhibit 2, reproduced below, consists of Narton's specimen of use submitted in conjunction with its application in 1991, and a printout from HP's website:



HP TouchSmart / Main

Page 1 of 1



HP's motion notably fails to refute or explain Exhibit 2. Pursuant to Fed. R. Civ. P. 56(c), the Board must consider "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits" in deciding a motion for summary judgment. It is clear that HP's responses to discovery requests relating to HP's intent in selecting TOUCHSMART are germane to the pending motion for summary judgment. As such, HP's obligation to respond to such discovery requests should not be deemed suspended.

III. CONCLUSION

For the foregoing reasons, Nartron asks that the Board deny HP's Motion to Suspend with respect to HP's duty to respond to outstanding discovery requests, and further requests that the Board compel HP to respond to Nartron's First Set of Interrogatories and Rule 34 Requests, with objections waived.

Respectfully submitted,

BROOKS KUSHMAN P.C.

By:



ROBERT C.J. TUTTLE

HOPE V. SHOVEIN

1000 Town Center,

Twenty-Second Floor

Southfield, Michigan 48075

(248) 358-4400

Attorneys for Petitioner

Dated: October 20, 2009

CERTIFICATE OF SERVICE

I certify that I served:

**PETITIONER'S COMBINED BRIEF
IN OPPOSITION TO RESPONDENT'S MOTION TO SUSPEND
AND IN SUPPORT OF PETITIONER'S MOTION TO COMPEL**

on October 20, 2009 by:

 delivering

✓ mailing (via First-Class mail)

a copy to:

JEFFREY E. FAUCETTE
DIANA D. DiGENNARO
HOWARD, RICE, NEMEROVSKI,
CANADY, FALK & RABKIN
Three Embarcadero Center
Seventh Floor
San Francisco, CA 94111

Attorneys for Respondent

Hope Shover

EXHIBIT 1

PETITIONER'S COMBINED BRIEF
IN OPPOSITION TO RESPONDENT'S MOTION TO SUSPEND
AND IN SUPPORT OF PETITIONER'S MOTION TO COMPEL

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

NARTRON CORPORATION

Petitioner,

v.

Cancellation No. 92050789

**HEWLETT-PACKARD
DEVELOPMENT COMPANY, L.P.,**

Respondent.

**PETITIONER'S FIRST SET OF
INTERROGATORIES TO RESPONDENT**

Petitioner, Nartron Corporation ("Petitioner" or "Nartron"), submits the following Interrogatories to Hewlett-Packard Development Company, L.P. ("Respondent"), in accordance with Fed. R. Civ. P. 33 and Rule 2.120 of the Trademark Rules of Practice. Applicant requests that Opposers serve upon Applicant sworn answers to these Interrogatories within thirty (30) days of service, by delivering the answers to Brooks Kushman P.C., 1000 Town Center, 22nd Floor, Southfield, Michigan 48075. These Interrogatories are intended to be continuing in nature and any information that may be discovered subsequent to the service by Opposer of its responses should be brought to Applicant's attention through supplemental answers within a reasonable time following such discovery.

For the convenience of the Board and the parties, Applicant requests that each Interrogatory be quoted in full immediately preceding the response.

CLAIMS OF PRIVILEGE

If any information responsive to any of the following Interrogatories is withheld on the basis of privilege and/or work-product, the following information is requested with respect to any such refusal: (1) the privilege and/or work-product rule of law being relied upon; (2) the date the document was created; (3) the identity of the person or persons who created the document; (4) the identity of the present custodian; (5) the addressee(s) and all other recipients of the document; (6) the subject matter of the document; and (7) the location of the document.

DEFINITION OF TERMS

These Interrogatories are subject to the following definitions:

1. The term “person” or “individual” includes, but is not limited to, any natural person, corporation, partnership, sole proprietorship, or any other business or legal entity, or any employee, agent, or representative of the foregoing.
2. The term “identify,” when referring to a person, means state the full name, last known home and business address, employer, and job title of such person.
3. The term “identify,” when referring to a document, means state the general nature or type, the general subject matter, title, number of pages, date, author or originator, addressee or recipient, copy recipients, present depository or depositories, name and address of any person(s) having custody, and any other necessary basis for identification of such document. If not provided contemporaneously with the answer, set forth all substantive portions or terms of the document.
4. The term “Petitioner” refers to Nartron Corporation, the Petitioner in this action, its predecessor or successor corporations, and any of its subsidiaries, divisions, affiliates, foreign affiliates and present and former agents, employees, directors, officers, trustees, attorneys, representatives, research and development personnel, and any other person or entity acting in concert

with Petitioner or on behalf of Petitioner.

5. The terms “you,” “your” or “Respondent” refers to Hewlett-Packard Development Company, L.P. , either individually or in combination, as well their predecessor or successor corporations, and any of its subsidiaries, divisions, affiliates, and present and former agents, employees, directors, officers, trustees, attorneys, representatives, research and development personnel, and any other person or entity acting in concert with Respondent or on behalf of Respondent.

6. Whenever the Interrogatories refer to “Petitioner’s Mark,” they refer to the SMART TOUCH trademark identified in Registration No. 1,681,891.

7. Whenever the Interrogatories refer to “Respondent’s Mark,” they refer to the TOUCHSMART trademark identified in Registration No. 3,600,880.

8. The term “and” includes the term “or”, and the term “or” includes the term “and.”

9. The term “documents” refers to the broadest definition of document under the Federal Rules of Civil Procedure, including drawings, specification, memorandums, and information in computer-readable formats and stored on computer media including but not limited to mass storage devices such as floppy diskettes, hard disks, and also includes e-mail and other documents stored on computer media.

10. The singular of any word includes the plural and the plural of any word includes the singular.

INTERROGATORIES

INTERROGATORY NO. 1.

Identify by name, title, and business address, persons knowledgeable of Respondent's use of TOUCHSMART for *each* of the goods recited in U.S. Registration No. 3,600,880, as of the claimed date of first use, *i.e.*, January 29, 2007.

RESPONSE:

INTERROGATORY NO. 2.

State in factual detail the relationship(s) between and among: (i) Respondent Hewlett Packard Development Company, L.P., (ii) HPQ Holdings, LLC, and (iii) Hewlett Packard Co., including:

- (a) business relationship(s),
- (b) licensor-licensee relationship(s) (if any),
- (c) parent-subsidary relationship(s) , and
- (d) common management and control.

RESPONSE:

INTERROGATORY NO. 3.

Identify by name, title, and business address, persons knowledgeable of the plans of Respondent for marketing the TOUCHSMART goods of U.S. Reg. No. 3,600,880.

RESPONSE:

INTERROGATORY NO. 4.

State Respondent's position on *duPont* Factor No. 1, viz:

The similarity or dissimilarity of the marks [SMART TOUCH and TOUCHSMART] in their entirety as to appearance, sound, connotation and commercial impression.

RESPONSE:

INTERROGATORY NO.5.

State Respondent's position on *duPont* Factor No. 2, viz:

The similarity or dissimilarity in nature of the goods and goods as described in an application or registration or in connection with which a prior mark is in use.

RESPONSE:

INTERROGATORY NO. 6.

State Respondent's position on *duPont* Factor No. 3, viz:

The similarity or dissimilarity of established, likely-to-continue trade channels.

RESPONSE:

INTERROGATORY NO. 7.

State Respondent's position on *duPont* Factor No. 6, viz:

The number and nature of similar marks in use on similar goods.

RESPONSE:

INTERROGATORY NO. 8.

State Respondent's position on *duPont* Factor No. 11, viz:

The extent to which Respondent has a right to exclude others from use of its mark on its goods.

RESPONSE:

INTERROGATORY NO. 9.

State the factual basis for Respondent's First Affirmative Defense: "Petitioner's action is barred by the doctrine of waiver or estoppel," according to the proof elements for the "waiver" and "estoppel" defenses (in *inter partes* proceedings before the Trademark Trial And Appeal Board, not trademark infringement actions).

RESPONSE:

INTERROGATORY NO. 10.

In reference to the "Second Affirmative Defense" asserting: "Petitioner's action is barred by the doctrine of laches or acquiescence," state according to the proof elements for the "laches" and "acquiescence" defenses (in *inter partes* proceedings before the Trademark Trial And Appeal Board, not trademark infringement actions) the factual bases for these defenses.

RESPONSE:

INTERROGATORY NO. 11.

In reference to the “Third Affirmative Defense” asserting: “Petitioner’s action is barred because Petitioner acted with unclean hands,” state according to the proof elements for the “unclean hands” defense (in *inter partes* proceedings before the Trademark Trial And Appeal Board, not trademark infringement actions) the factual bases for this defense.

RESPONSE:

INTERROGATORY NO. 12.

Identify the circumstances under which and the date on which Respondent became aware of Petitioner’s Mark.

RESPONSE:

INTERROGATORY NO. 13.

Identify documents containing any advice of counsel upon which Respondent will rely to show good faith in its adoption and use of the “TOUCHSMART” mark.

RESPONSE:

INTERROGATORY NO. 14.

Identify any advertising agency engaged by Respondent to advertise and promote Respondent’s goods under its “TOUCHSMART” mark, including the names, titles, and business addresses of the advertising agency employees having the most knowledge of such advertising and promotion.

RESPONSE:

INTERROGATORY NO. 15.

Identify each person who participated in the preparation of Respondent's responses to the foregoing interrogatories or furnished any information used in responding to each interrogatory, specifying the interrogatory response for which each such person participated in the preparation or contributed information.

RESPONSE:

INTERROGATORY NO. 16.

Identify by name, business address and contact data, each of the "partners" referred to in the following quotation from the 2008 Form 10-K of Hewlett Packard Company:

Sales, Marketing and Distribution

...


Our customers are organized by consumer and commercial customer groups, and distribution is organized by direct and channel. Within the channel, we have various types of **partners** that we utilize for various customer groups. The **partners** include:

- retailers that sell our products to the public through their own physical or Internet stores; resellers that sell our products and services, frequently with their own value-products or services, to targeted customer groups;
- distribution partners that supply our solutions to smaller resellers with which we do not have direct relationships;
- independent distributors that sell our products into geographies or customer segments in which we have little or no presence;
- original equipment manufacturers ("OEMs") that integrate our products with their own hardware or software and sell the integrated products;
- independent software vendors ("ISVs") that provide their clients with specialized software products, frequently driving sales of additional non-HP products and services, and often assist us in selling our products and services to clients purchasing their products; and
- systems integrators that provide various levels and kinds of expertise in designing and implementing custom IT solutions and often partner with HPS [HP Services] to extend their expertise or influence the sale of our products and services.

RESPONSE:

Respectfully submitted,

BROOKS KUSHMAN P.C.

By: 

ROBERT C.J. TUTTLE
HOPE V. SHOVEIN
1000 Town Center
Twenty-Second Floor
Southfield, Michigan 48075

Attorneys for Petitioner

Dated: *August 27, 2009*

CERTIFICATE OF SERVICE

I certify that I served:

**PETITIONER'S FIRST SET OF
INTERROGATORIES TO RESPONDENT**

on August 27, 2009 by:

_____ delivering
X mailing (via First Class Mail)

a copy to:

Mr. Jeffrey E. Faucette
Ms. Diani D. DiGennaro
HOWARD, RICE, NEEROVSKI
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Attorneys for Respondent



Hope V. Shovein

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

NARTRON CORPORATION

Petitioner,

v.

Cancellation No. 92050789

**HEWLETT-PACKARD
DEVELOPMENT COMPANY, L.P.,**

Respondent.

**PETITIONER'S FIRST SET OF
RULE 34 REQUESTS TO RESPONDENT**

Petitioner, Nartron Corporation, hereby requests Respondent, Hewlett-Packard Development Company, L.P., to produce for inspection and designation for copying documents and tangible things responsive to the items or categories described in the following numbered paragraphs at the offices of Petitioner's counsel, Brooks Kushman P.C., 1000 Town Center, Twenty-Second Floor, Southfield, Michigan 48075, within thirty (30) days from the date of service hereof, or at such other location and on such other date as may be agreed to by counsel.

DEFINITIONS AND INSTRUCTIONS

Applicant hereby incorporates by reference the definitions and instructions set forth in Petitioner's First Set of Interrogatories to Respondent.

DOCUMENT REQUESTS

DOCUMENT REQUEST NO. 1.

Documents substantiating Respondent's use of TOUCHSMART for *each* of the goods recited in U.S. Registration No. 3,600,880, as of the claimed date of first use, *i.e.*, January 29, 2007.

RESPONSE:

DOCUMENT REQUEST NO. 2.

Documents relating to any investigation of the availability for use of the mark TOUCHSMART for *each* of the goods recited in U.S. Registration No. 3,600,880, including searches, search reports, and the like.

RESPONSE:

DOCUMENT REQUEST NO. 3.

Documents relating or referring to any plans for marketing TOUCHSMART for *each* of the goods recited in U.S. Registration No. 3,600,880.

RESPONSE:

DOCUMENT REQUEST NO. 4.

Documents relating or referring to any survey, focus group, or similar form of market study concerning potential or actual use of TOUCHSMART by Respondent.

RESPONSE:

DOCUMENT REQUEST NO. 5.

Marketing and promotional materials (hard copy and electronic) showing actual use of TOUCHSMART by Respondent.

RESPONSE:

DOCUMENT REQUEST NO. 6.

Documents relevant to *duPont* Factor No. 1, viz:

The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

RESPONSE:

DOCUMENT REQUEST NO. 7.

Documents relevant to *duPont* Factor No. 2, viz:

The similarity or dissimilarity in nature of the goods and services as described in an application or registration or in connection with which a prior mark is in use.

RESPONSE:

DOCUMENT REQUEST NO. 8.

Documents relevant to *duPont* Factor No. 3, viz:

The similarity or dissimilarity of established, likely-to-continue trade channels.

RESPONSE:

DOCUMENT REQUEST NO. 9.

Documents relevant to *duPont* Factor No. 6, viz:

The number and nature of similar marks in use on similar goods.

RESPONSE:

DOCUMENT REQUEST NO. 10.

Documents relevant to *duPont* Factor No. 11, viz:

The extent to which applicant has a right to exclude others from use of its mark on its goods.

RESPONSE:

DOCUMENT REQUEST NO. 11.

Documents substantiating Respondent's "First Affirmative Defense" of waiver or estoppel.

RESPONSE:

DOCUMENT REQUEST NO. 12.

Documents substantiating Respondent's "Second Affirmative Defense" of laches or acquiescence.

RESPONSE:

DOCUMENT REQUEST NO. 13.

Documents substantiating Respondent's "Third Affirmative Defense" of unclean hands.

RESPONSE:

DOCUMENT REQUEST NO. 14.

Documents recording any advice of counsel upon which Applicant will rely to show good faith in its adoption and use of the TOUCHSMART mark.

RESPONSE:

DOCUMENT REQUEST NO. 15.

Documents sufficient to identify by name, business address and contact data, each of the "partners" referred to in the following quotation from the 2008 Form 10-K of Hewlett Packard Company:

Sales, Marketing and Distribution

...

Our customers are organized by consumer and commercial customer groups, and distribution is organized by direct and channel. Within the channel, we have various types of **partners** that we utilize for various customer groups. The **partners** include:

- retailers that sell our products to the public through their own physical or Internet stores; resellers that sell our products and services, frequently with their own value-products or services, to targeted customer groups;
- distribution partners that supply our solutions to smaller

resellers with which we do not have direct relationships;

- independent distributors that sell our products into geographies or customer segments in which we have little or no presence;
- original equipment manufacturers ("OEMs") that integrate our products with their own hardware or software and sell the integrated products;
- independent software vendors ("ISVs") that provide their clients with specialized software products, frequently driving sales of additional non-HP products and services, and often assist us in selling our products and services to clients purchasing their products; and
- systems integrators that provide various levels and kinds of expertise in designing and implementing custom IT solutions and often partner with HPS [HP Services] to extend their expertise or influence the sale of our products and services.

RESPONSE:

DOCUMENT REQUEST NO. 16.

All documents not otherwise listed in answer to the interrogatories and document requests, which were referred to or relied upon to prepare the answers to the interrogatories and document requests.

RESPONSE:

Respectfully submitted,

BROOKS KUSHMAN P.C.

By: 

ROBERT C.J. TUTTLE
HOPE V. SHOVEIN
1000 Town Center
Twenty-Second Floor
Southfield, Michigan 48075

Attorneys for Petitioner

Dated: *August 27, 2009*

CERTIFICATE OF SERVICE

I certify that I served:

**PETITIONER'S FIRST SET OF
RULE 34 REQUESTS TO RESPONDENT**

on August 27, 2009 by:

_____ delivering
 X mailing (via First Class Mail)

a copy to:

Mr. Jeffrey E. Faucette
Ms. Diani D. DiGennaro
HOWARD, RICE, NEEROVSKI
CANADY, FALK & RANKIN
Three Embarcadero Center, 7th Floor
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Attorneys for Respondent



Hope V. Shovein